

Remarks:

Reconsideration of the application is requested.

Claims 1 to 14 remain in the application. Claims 2 and 12 have been amended. Claims 1 to 12 are subject to examination and claims 13 and 14 have been withdrawn from examination.

In items 1 to 5 on pages 2 to 3 of the above-identified Office action, the Examiner required confirmation of the provisional election. Applicants hereby confirm the provisional election, made on June 14, 1999, to prosecute the invention of Group I, claims 1 to 12. Applicants also retract traversal of the provisional election and prosecute the instant application without traverse.

In item 6 on page 3 of the above-identified Office action, the Examiner objected to claim 12 as being the same as claim 11. Applicants have corrected a typographical error in claim 12 by having claim 12 depend from claim 2. Accordingly, applicants respectfully believe that claim 12, as amended, is not the same as claim 11.

In item 8 on page 4 of the above-identified Office action, claims 1 to 12 have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph. More specifically, the Examiner stated that the term "and the like" in claim 2 was

vague or indefinite. Applicants have amended claim 2 to eliminate this phrase.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, second paragraph. The above noted changes to the claims are provided solely for the purpose of satisfying the requirements of 35 U.S.C. § 112. The changes are not provided for overcoming the prior art.

In item 9 on page 4 of the above-indicated Office action, claims 1, 3, 5, 7, 11 and 12 were rejected as being fully anticipated by Parker (U.S. 648,632) under 35 U.S.C. § 102. Particularly, the Examiner states that the "board of Parker can be evacuated." Applicants respectfully disagree with this conclusion.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the references.

Parker relates to a board for preparing pastry goods. See Parker at page 1, lines 8 to 14. Parker discloses two thin-walled sheets of metal 2, 3 spaced apart and connected to one another by a fold connection 2a, 2b, 2c, 3a, 3b, 3c. Parker

provides that "strawboard, pasteboard, or analogous absorbent material" should be disposed between the metal plates 2, 3 as a "cushion." Parker at page 1, lines 17 to 18. One skilled in the art would understand, without question, that a simple fold connection of two sheet-metal plates, supported one against the other by cardboard, creates a board that is entirely unsuitable for vacuum insulation. As clearly set forth in claim 1 of the instant application, in contrast, the "two outer covering layers [are] connected to one another in a vacuum-tight manner by [the] connecting profile." (Emphasis added by applicants.)

A further unequivocal indication of the Parker board being unsuitable for vacuum insulation is its eyelet 5 -- which adapts the Parker board "to be suspended from or hung on a suitable hook or nail when not in use." Parker at page 1, lines 77 to 80. The eyelet is precisely opposite to that which is required in accordance with the instant application. Claim 1 specifically provides that the tubular section 23, 31 of the invention of the instant application must be "fixed in a vacuum-tight manner in said aperture of said at least one of said two covering layers [13, 14]." These features are neither disclosed by nor suggested from Parker's specification, and they are especially not apparent from Figs. 2 to 4 of Parker. In contrast, Parker's eyelet 5 extends over the two sheet-metal plates 2, 3 at least in a way that the

eyelet 5 collar protrudes at least partially beyond the outer faces of the plates 2, 3 to insure that the eyelet section that remains between the two collar sections penetrates the plates 2, 3. This construction type has been mentioned in the instant application, wherein it is disclosed that the construction has a disadvantage that the plate 2, 3 openings must be aligned with one another with an extremely high degree of precision in order to insure vacuum-tight insertion of a tube connector. See specification of the instant application at page 2, line 5, to page 3, line 4.

Parker's specific construction contradicts the idea that its board (a device completely different from the panel of the instant application) was ever intended for being thermally insulated based upon vacuum insulation technology.

Accordingly, applicants respectfully believe that the technology and the field of technology disclosed by Parker are not analogous to the invention of the instant application. Further, Parker clearly does not show "two outer covering layers connected to one another in a vacuum-tight manner by said connecting profile" as recited in claim 1 of the instant application.

Applicants, therefore, believe that Parker does not anticipate the claim 1 of the invention of the instant application and that claim 1 is patentable. Insofar as claims 2 through 12

are all dependent upon claim 1, applicants believe that these claims are patentable as well.

In item 12 on page 5 of the above-identified Office action, claims 1 to 12 have been rejected as being obvious over Schmidberger (DE-AS 1,004,207) in view of Conrad et al. (U.S. 3,108,840; hereinafter "Conrad") under 35 U.S.C. § 103. Applicants respectfully traverse the rejection.

Schmidberger discloses a refrigerator casing having inner and outer linings formed from individual, specially pre-shaped plastic panels -- a material different from that suggested and relied upon by the Examiner in item 12 of the Office action. Foam material, serving as thermal insulation, is filled in between Schmidberger's inner and outer linings (which are spaced apart from one another) in order to increase rigidity of the panels. Also to increase rigidity, tubular spacing elements (Fig. 3) are welded between the inner and outer linings to those sides of the inner and outer linings that face one another. Schmidberger's tubular spacing elements serve as supporting webs to support the inner and outer linings against one another. The inner and outer linings have low flexural and torsional strength because of the material used, and the spacing elements are used with the aim of overcoming the casing configuration weakness. See Schmidberger at col. 4, lines 53 to 64.

Due to the fact that the Schmidberger casing is made up of individual plastic panel sections connected by joints, applicants believe that one skilled in the art would clearly know that the Schmidberger casing structure is completely unsuitable for thermal insulation based on vacuum insulation technology. Accordingly, the problem areas that occur specifically in the context of vacuum insulation technology are entirely unrelated to and unaddressed by Schmidberger's casing configuration. Further, Schmidberger does not address the specific problem areas that are solved by the invention of the instant application. Accordingly, applicants respectfully believe that Schmidberger is unrelated to the art of the invention of the instant application.

Similarly, because Schmidberger is different from the invention of the instant application both in terms of its object and also in terms of its contents, applicants believe that the combination with Conrad does not suggest, to one skilled in the art, the features of claim 1 of the instant application.

Conrad discloses a metal storage vessel that is thermally insulated using vacuum insulation technology. The vessel has an outer sleeve 15 and an inner sleeve 16 spaced apart from the outer sleeve. The intermediate space 14 that is produced

by the distance between the two sleeves is filled with a thermally insulating material. The inner sleeve 16 bounds a receptacle space that is accessible through a cylindrical metal neck member 21. The only disclosure related to the neck 21 can be found at col. 3, line 72, to col. 4, line 5, and col. 5, lines 58 to 67, therein. The disclosure provides that a tube connector is used to produce the neck 21. The connector bridges the intermediate space (filled with thermally insulating material) and connects both to the inner and outer sleeves in a vacuum-tight fashion. For the purpose of vacuum-tight attachment of the tube connector, projections for receiving the tube connector are formed on the inner and outer sleeves 15, 16.

The Conrad vacuum-insulated storage vessel shows very clearly the development state of the relevant field of vacuum insulation technology before the invention of the instant application with respect to the problem of attaching a tube connector to a sleeve layer opening in a vacuum-tight fashion. It is clear from Conrad that molded elements for vacuum-tight attachment of the tubular section are provided on the cover layers. This construction has the same disadvantage discussed above. Specifically, the molded elements require precise alignment of the two sleeve layers with one another in order to insure that the welded vacuum-tight connection of the

tubular section to the cover layers is reliable in terms of processing during large-scale fabrication.

In contrast with the view expressed in item 12 of the Office action, applicants respectfully believe that Schmidberger -- which was published years before Conrad and applies to plastic materials -- did not influence the development of thermally insulated walls and vessels using vacuum insulation technology. Accordingly, applicants believe that Schmidberger is not analogous to the art of the invention of the instant application. Instead, those skilled in the art stayed with a sealing principle that had been known for years -- a principle that is implemented in Conrad. Applicants believe that Parker, a reference older than Conrad, did not influence developments in the field of vacuum thermal insulation technology.

Despite the differences between art of Conrad and Schmidberger, the Examiner rejects claims 1 to 12 of the instant application by combining these two references. The Examiner states that "it would have been obvious for one having an ordinary skill in the art to have modified Schmidberger with steel walls and a tube with all parts welded for the purpose of providing a cold storage container in view of Conrad." The Examiner, however, never addresses, or even acknowledges, the differences between the fields of the two



references. Further, the Examiner provides no motivation or suggestion within the two references to make the comparison or the combination of these two different fields.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). Applicants believe that there is no teaching or suggestion in Schmidberger to incorporate the features of Conrad and there is no teaching or suggestion in Conrad to incorporate the features of Schmidberger.

Alternatively, applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teachings are present in the cited references.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1.

In view of the foregoing, reconsideration and allowance of claims 1 to 12 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a

telephone call so that, if possible, patentable language can be worked out.

Petition for extension is herewith made. The extension fee for response within a period of one (1) month pursuant to Section 1.136(a) in the amount of \$110.00 in accordance with Section 1.17 is enclosed herewith.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

  
For Applicants

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GLM:csn

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